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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/822,051	04/10/2004	Ronald John Rosenberger		2238

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Ronald Rosenberger
506 Sterling St.
Newtown, PA 18940

EXAMINER

KAVANAUGH, JOHN T

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 03/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/822,051	Applicant(s) ROSENBERGER, RONALD JOHN	
	Examiner Ted Kavanaugh	Art Unit 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Upon initial review of applicant's response filed March 14, 2006, the examiner contacted the applicant to request clarification of claim 1, line 9. It was concluded that "or" should be deleted or otherwise the claim would be indefinite. The applicant agreed and the application was examined as it was deleted. Any future amendment should reflect this.

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "scented material/formulation compound", "a void", "a receptacle", "a hole", "an 'O' ring", "multi-sectional construction", "visual aspect" and "two or more novelty plus or inserts" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. Applicant filed a figure to show these features but the o-ring doesn't correspond to the description provided in the specification. Also, the claims and specification describe the void, receptacle and hole and 3 different elements and now the figure shows them as one.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet,

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and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

2. The disclosure is objected to because of the following informalities: Applicant provided a new figure but the specification was not amended accordingly.

Appropriate correction is required.

3. The amendment filed March 14, 2006 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The new figure 1 has new matter. There is no support for the O-rings as claimed. The specification call for the O-ring to be "around the non-wearing circumference of the sole" or "around the heel" at page 11 of the specification. From the description provided one would not conclude a ball shaped O-ring as now shown in figure 1. Also the figure doesn't show an accurate shape of a shoe sole. Sole do not have the shape of the sole as shown in

figure 1. The figure also shows the "void", "hole" and "receptacle" as the same element which is not consistent with the description and what is being claimed, see claim 6, "said void comprising a receptacle" and "void comprises a hole".

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 9 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The "void can accommodate said at least one novelty scented plug or insert comprising any embodiment of an 'O' ring around the non-wearing circumference of the entire shoe sole" is not clear. The description of the "ring" in the specification was not understood and therefore it is not possible to make and/or use the invention.

6. Claims 1-7,9-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The scope of the term "etc.", see claim 15 for an example, used throughout the claims, is not known and therefore it is not clear of the metes and bounds of such expressions. What further elements would be included with the expression "etc."?

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Claim 6 is unclear inasmuch as the plug, which contains the scented material/compound, is only functionally recited. The scented material was positively recited in claim 1 but now in claim 6 the plug is only functionally recited and therefore the scope of the claim is not clear.

In claim 7, the phrase "does not comprise said at least one scented...smoking means" is not understood. Is application trying to claim the sole, the void, the receptacle or the plug doesn't have these features?

Claim 18 is not clear. The plug or insert having a multi-sectional construction is not understood.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by US 4257176 (Hartung et al).

Hartung teaches a shoe sole (insole) comprising a novelty scented compound wherein the compound gives off a unique aroma when said sole is in normal use due to friction, heat buildup and wear (see col. 1, line 48 to col. 2, line 5).

9. Claims 1,6-7,9,11,14,15,17,18,19-21 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5732485 (Laughlin et al).

Laughlin teaches a shoe sole comprising a novelty scented compound wherein the compound gives off a unique aroma when said sole is in normal use due to friction, heat buildup and wear (see col. 2, lines 31-36), wherein said shoe sole comprises a void having a receptacle (see figures 1,2 and 4) for insertion of a plug (14). Regarding claim 9, the "O" ring is shown retainer 2, see figure 2. Regarding claim 11, the sole of Laughlin has at least one color. Regarding claims 19-21, these claims consist of functional language and the sole of Laughlin is inherently capable of performing all of the functional language as claimed. Regarding claim 15, the plug as shown in figure 2 provide a novel visual aspect.

Claim Rejections - 35 USC § 103

10. Claims 8 and 12,13 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over US 5732485 (Laughlin et al).

Laughlin teaches a shoe sole as claimed (see the rejection above) but is silent with regard to the means of creating the void. This limitation is being treated as a product by process limitation. Thus, it would appear obvious to make the void by a number of different conventional known means.

11. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Laughlin '485.

Laughlin teaches the shoe sole as claimed except for the plugs being in a side by side arrangement. Although, Laughlin teaches the plug in different locations, see figure 3 and 4. It would appear to be an obvious design choice to provide two plugs (scented material) in a side by side relationship, inasmuch as the plugs can be located in a

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number of different locations and obviously the more plugs provided the better deodorizer for masking foot odor.

12. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Laughlin '485 in view of US 5024008 (Maples).

Laughlin teaches a shoe sole as claimed except for the scent means compound having one pheromone. Maples teach the sole scented dispenser having an animal lure scent (i.e. pheromone); see col. 3, lines 15-20. It would have been obvious to provide the scent compound with one of a pheromone, as taught by Maples, for a hunter to lure an animal.

13. Claim 3 and 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Laughlin '485 in view of US 5261169 (Williford).

Laughlin teaches a shoe sole as claimed except for the scent means compound comprising smoking means. The smoking means is the result of powder being used. Williford teaches a sole having a scented means comprising power (36). It would have been obvious to one of ordinary skill in the art for the scented compound to be a powder, as taught by Williford, to provide a scented composition and an antimicrobial composition.

14. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laughlin '485 in view of US 5039243 (O'Brien).

Laughlin teaches a shoe sole as claimed except for the shoe comprising materials that are colored in accordance to the scent of the shoe sole. O'Brien teaches

the colors and the scents corresponding to each other, see the abstract. It would have been obvious to one of ordinary skill in the art to shoe sole of Laughlin with a color and scent that correspond with each other, as taught by O'Brien, to provide a pleasing appearance.

Response to Arguments

15. Applicant's arguments filed March 14, 2006 have been fully considered but they are not persuasive.

Regarding the 35 USC 112, 1st paragraph rejection above, applicant refers to page 11 and 12 and states claim 9 has been amended to clarify such issues.

In response, claim 9 has not been amended as such, only the term "novelty" has been deleted to correct an indefinite issue. The examiner has review pages 11 and 12 again and the issue still remains. Applicant has not amended claim 9 to clarify anything and/or the specification hasn't been amended as such. Applicant has added a new figure but this only adds further discrepancies in this application.

Regarding the 35 USC 112, 2nd paragraph rejection above, applicant states the claims have been amended to more definitely recite what Applicant regards to be his invention.

In response none of the changes, other than deleting "novelty" and canceling claim 8, address the 112 2nd paragraph issues.

Applicant argues that the term "smoking means" is definite under 35 USC 112 2nd paragraph.

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In response, the examiner never alleged that the phrase "smoking means" was indefinite. The phrase "does not comprise at least one scented...smoking means", in claim 7, was indefinite because it is not clear if applicant is trying to claim the sole, the void, the receptacle or the plug which do not have these features.

Regarding "the multi-sectional construction", the Applicant refers to page 13 of the specification. The examiner read page 13 of the specification again and the issues still exist. Claim 18 is not clear. The plug or insert having a multi-sectional construction is not understood. Moreover, the figure still doesn't show this feature.

Regarding the Art Rejections:

Applicant argues that the present invention does not recited, disclose or include insoles, but discloses and claims shoe soles.

In response, an insole is a sole. The term sole includes insoles, inserts, midsoles, outer soles, outsoles, innersoles, etc. Both Laughlin and Hartung teach insole and therefore teach a sole as claimed.

Applicant argues neither the insole of Laughlin or Hartung come in direct contact with outside ground surfaces such as pavement, floor covering, etc.

In response, such features are not claimed and therefore are moot. Moreover, insole are capable of being removed from shoes and contact ground surfaces.

Regarding the 35 USC 103 rejections given, applicant argues there is no motivation provided to combine the references.

To the contrary, each rejection has motivation. See the last sentence of each of the combination provided above for the motivational statement.

Conclusion

16. An examination of this application reveals that applicant is unfamiliar with patent prosecution procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed. Applicant is advised to secure the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skilled preparation and prosecution. The Office cannot aid in selecting an attorney or agent.

A listing of registered patent attorneys and agents is available on the USPTO Internet web site <http://www.uspto.gov> in the Site Index under "Attorney and Agent Roster." Applicants may also obtain a list of registered patent attorneys and agents located in their area by writing to the Mail Stop OED, Director of the U. S. Patent and Trademark Office, PO Box 1450, Alexandria, VA 22313-1450.

It is suggested if applicant wishes to continue processing his application that he have his registered Patent Attorney file a Continuation-in-Part Application and make sure an adequate description and drawings are provided.

It is also noted that applicant's Drawing is informal and Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings.

17. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

18. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

19. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Other useful information can be obtained at the PTO Home Page at www.uspto.gov.

In order to avoid potential delays, Technology Center 3700 is encouraging FAXing of responses to Office Actions directly into the Center at (571) 273-8300 **(FORMAL FAXES ONLY)**. Please identify Examiner Ted Kavanaugh of Art Unit 3728 at the top of your cover sheet.

Any inquiry concerning the MERITS of this examination from the examiner should be directed to **Ted Kavanaugh whose telephone number is (571) 272-4556**. The examiner can normally be reached from 6AM - 4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562.


Ted Kavanaugh
Primary Examiner
Art Unit 3728

TK
March 22, 2006